

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number Q94362	
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number	Filed	
	10/575,095	April 10, 2006	
	First Named Inventor		
	Alexandra PARMENTIER		
	Art Unit	Examiner	
	3752	Davis D. HWU	
<p style="text-align: center;">WASHINGTON OFFICE 23373 CUSTOMER NUMBER</p>			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal</p> <p>The review is requested for the reasons(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p><input checked="" type="checkbox"/> I am an attorney or agent of record.</p> <p>Registration number 43,078</p>			
		<p style="text-align: center;"><i>Raja N. Saliba</i> _____ Signature</p>	
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		<p style="text-align: center;">April 8, 2009 _____ Date</p>	

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q94362

Alexandra PARMENTIER, et al.

Appln. No.: 10/575,095

Group Art Unit: 3752

Confirmation No.: 9386

Examiner: Davis D. HWU

Filed: April 10, 2006

For: FLUID PRODUCT DISPENSING HEAD AND PRODUCTION METHOD THEREOF

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated January 8, 2009, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

I. Claim Rejections - 35 U.S.C. § 103

Claims 1-3, 8, 11-13, 15 and 16 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Montaner et al. (US 5,025,958). The grounds of rejection state:

Montaner et al. discloses a fluid dispenser head associating with a fluid dispenser member, the head comprising a body 8 defining a fluid outlet channel, a nozzle defining a dispenser orifice, a cover 4 assembled on the body to mask the body at least in part, and a skirt as recited in claim 8 (see Fig. 1 enclosed herein). Regarding the cover being overmolded on the body, whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable.

* * *

Applicant's arguments filed November 12, 2008 have been fully considered but they are not persuasive. The cover being overmolded on the body is a product-by-process statement and although Montaner et al. do not disclose the cover being overmolded on the body, it does not render the device patentable because the prior art discloses the claimed structural limitations.

(Office Action, dated January 8, 2009, pages 2-3).

Regarding claim 1, Montaner neither discloses, nor renders obvious, at least “the head being characterized in that the cover (3) is overmolded on the body (1).” The Examiner takes the position with regard to the recited overmolding that “whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable.” (Office Action at page 2.) The Examiner’s position that the term “overmolded” should not be given patentable weight is legally incorrect.

“The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art” (See MPEP § 2113, last paragraph.) Structure is implied “especially . . . where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product.” (See MPEP § 2113 (citing *In re Garnero*, 412 F.2d 276 (CCPA 1979) (holding that the terms “interbonded by interfusion,” “welded,” “intermixed,” “ground in place,” “press fitted,” and “etched” are capable of construction as structural limitations.)))

Applicants respectfully submit that the recitation of “overmolded” not only implies, but actually imparts distinctive structural characteristics onto the claimed product. For example, as defined in the specification of the current application:

The term “overmolding” means that the body itself forms a portion of the mold used to make the cover. Thus, a portion of the outside surface of the plastics material that is injected into the mold to make the cover comes directly into intimate contact with the body. This contact forms a bond that results in the cover being securely fastened on the body. This overmolding technique ensures that the cover follows all the contours and roughnesses of the body intimately.”

(Current application, page 2, lines 3-12.) In view of this description, the term “overmolded” imparts distinctive structural characteristics into claim 1 that are not present in the prior art. One skilled in the art would readily appreciate the structural distinction. Indeed, a visual inspection of a dispenser head in accordance with the claim requirements would reveal the structure distinctly imparted by overmolding the cover onto the body.

Montaner does not disclose the structural characteristics that should be properly imparted into claim 1. Montaner depicts a cap 4, a diffuser 6, and a means 8 for coupling the rest of the assembly to the pump, where there is a distinct gap between the cap 4 and the means 8. (See Montaner, col. 2, lines 50-56; *see also* Figure 1 of Montaner.) As a result of the gap, the cap 4 is first formed and then attached to the means 8. One skilled in the art would know that the cap 4 in Montaner was not overmolded onto the means 8 as evident by, *inter alia*, the gap formed between the cap 4 and the means 8. As such, Montaner does not disclose a device having any of the distinctive structural characteristics that are present in claim 1.

Additionally, even though claim 1 is not rejected under 35 U.S.C. § 103, the Examiner has not established a *prima facie* case as to why it would have been obvious to modify Montaner to produce a cap 4 overmolded on the means 8. Courts have held that “rejections on obviousness cannot be sustained with mere conclusory statements; instead there must be some articulated

reasoning with some rational underpinning to support the legal conclusion of obviousness.” (*In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).)

The Examiner states that it would have been obvious to modify Montaner because:

[S]ince the cover 4 of Montaner et al. is permanently attached to body 8, it would also have been obvious to one having ordinary skill in the art at the time the invention was made that the cover would be overmolded onto the body since this is the quickest, most cost effective, and most efficient way of forming the parts for mass production of the device.

(Office Action, dated January 8, 2009, at page 3.) There is no support or any rational basis whatsoever for the conclusion that providing an overmolded cap on a spray pump would be quicker, more cost effective, or a more efficient way of forming parts. Thus, a prima facie case of obviousness has not been established.

Applicants respectfully submit that claims 2, 3, 8, 11, 15, and 16 are allowable at least by virtue of their dependency from independent claim 1.

Furthermore, regarding claim 3, the Examiner alleges that “overmolding the cover onto the nozzle would have been a matter of design choice since the device would still function properly with such an arrangement.” Again, merely alleging that the invention would have been obvious “[as] a matter of design choice [because] the device would still function properly with such an arrangement” amounts to a conclusory statement and does not establish a prima facie case of obviousness. Indeed, every invention must function properly to be patentable, so the proper functioning of an invention cannot render an invention obvious.

Regarding dependent claims 15 and 16, these claims respectively recite that the cover “forms an overmolded cover on the body” and “wherein the cover is overmolded onto the body

resulting in intimate contact between surfaces of the cover and of the body.” Regarding claim 15, Montaner does not disclose an “overmolded cover” as discussed above. Regarding claim 16, Montaner does not disclose that the cover and the body have intimate contact with each other. As such, Applicants respectfully submit that claims 15 and 16 are not anticipated by Montaner.

Regarding independent claims 12 and 13, the Examiner alleges that Montaner “discloses the structural limitations of the instant invention and the method of overmolding has already been discussed above.” (Office Action, dated January 8, 2009, page 2.) The discussion “above” that the Examiner is referring to discusses overmolded caps in the context of product claims. Claims 12 and 13, however, recite a method of manufacturing a fluid dispenser head using an overmolding process. Montaner does not disclose any steps for manufacturing a fluid dispenser head and does not render the claimed method steps obvious. Applicants respectfully submit that Montaner does not anticipate claims 12 and 13.

II. Conclusion

For the reasons presented above, Applicant respectfully submits that the claims are patentable, and accordingly, that the final rejection is improper. Applicant respectfully requests the Panel to reverse the final rejection and allow the application with the pending claims.

Respectfully submitted,



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